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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,473	01/19/2001	Steven D. Kim	MPAT.182C1	1039
24504	7590	03/29/2006		
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			EXAMINER LE, HIEU C	
			ART UNIT 2142	PAPER NUMBER

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,473

Applicant(s)

KIM ET AL.

Examiner

Hieu c. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/27/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 12-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,12 and 13-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/07/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The amendment filed on 10/27/05 has been entered and made record.
2. In response to applicant's amendment filed on 10/27/05 the objection to claims 18-23 is withdrawn.
3. In response to applicant's amendment filed on 10/27/05 the rejection to claims 13-17, 19-23 under 112, 2nd paragraph is withdrawn.

Warning

4. Applicant is advised that should claim 8 be found allowable, claim 9 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Arguments

5. The Applicant's argument filed 10/27/05 have been fully considered but they are not persuasive for the following reasons:

Applicant alleges that "Horman has not clearly explained "application configuration parameter" and contain no discussion at all of how the scrip [.,]" (p. 8, lines 8-11). The Examiner disagrees. Horman discloses parameterized scripts to change the state or configuration that they are programmed to effect and their target application the group of similarly configured managed entities (database servers) (col. 3, lines 6-14), i.e. application configuration parameters [The script template is instantiated into an actual script that a database server executes by replacing embedded parameters with

values specific to the database (col. 2, lines 50-61 & col. 3, lines 17-36)).

Applicant alleges that “ Dan does not teach “wherein each application program configuration parameter defines at least in part a set of resources on the server available to a particular customer of a web hosting provider [,]” (p. 8, lines 13-14). The Examiner disagrees. Firstly, Applicant’s argument are against the references individually, one can not show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)., *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Horman does not explicitly disclose that “ the set of resources available to a particular customer of a web hosting provider”. Dan et al. teaches that feature. Applicant alleges that “ Applicants will assume “set of resources on the server” [,]” (p. 9, lines 1-8). The Examiner disagrees. Horman discloses embedded parameters (application configuration application) to administer database servers of similar shared characteristics into single entities. The shared characteristics are the end-user application that runs on the database servers and the database definition that supports the application (i.e. resources of the servers) (col. 5, lines 5-63). Dan discloses managing web server resources by an ISP (col. 13, lines 42-45). Dan discloses an asset (resource) is available to everyone on the user’s web management team (col. 14, lines 35-37). User’s web management team of the ISP is a particular customer entity of the web hosting provider and everyone on that team is a particular customer because they are the ones to edit the web pages. Applicant alleges that “ Dan et al and Horman can not be meaningfully combined [,]”

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(p. 9, lines 9-18). The Examiner disagrees. Firstly, In response to applicant's

argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case to provide to enable users to interface with a web management server side application to eliminate the cost of shrink –wrapping and facilitate optional automatic online software upgrades.

Specification

6. Cross References need to be updated.

The disclosure is objected to because of the following informalities: Under cross references to related applications, the co-pending application status needs to be updated. The specific reference to the parent either (1) on an application data sheet. (2) in the first paragraph of the specification. For example: The first paragraph needs to say: This application is a continuation of 09/565,270 05/05/2000 PAT 6,842,769.

Priority

7. The effective filing date for the subject matter defined in the pending claims in this application is 01/19/2001.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 12,8-9,13-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,842,769. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons set forth below.

Claim 1, of the instant application recites all the limitations of Claim 1 of the '769 Patent (see pages 12-16). The claim invention in the instant application is fully disclosed

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in the patent and it is broader than the claim invention in the patent. No new invention or new improvement is being claimed in the instant application. Applicants are now attempting to claim broadly that which had been previously described in more detail in the claims of the patent (In re Van Ornum, 214 USPQ 761 CCPA 1982).

Regarding to claims 8-9,12,13-27 of the instant application, claims 2-22 of the patent recites all limitations in claims 2-22 (see pages 16, 18).

Claims Objection

10. Claim 25 is objected to under 37 C.F.R 1.75 (c) because it fails to refer back to and further limit another claim or claims in the same application. Claim 25 does not refer to another claim. It refers to itself. For purposes of prior art rejections in this office action, claim 25 will be construed as depending on claim 24.

Claim Rejections - 35 U.S.C. § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 24-26 are rejected under 35 U.S.C. 102(e) as anticipated by Horman (6,785,706).

As to claim 24, Horman discloses a method of *synchronizing configuration*

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configuration parameters on a server with a database of stored configuration parameters (col. 6, lines 11-17) comprising automatically updating [*a server application which provides a high-level view of how an administered server synchronize (col. 8, line 60-col. 9, line 5)*] at least one application program configuration parameter in response to updating at least one corresponding stored application configuration parameter in said database, wherein each application program configuration parameter [*embedded parameters*] defines at least in part a set of resources on the server [col. 2, lines 50-61 & col. 3, lines 17-36].

As to claim 24 is method claim corresponding to an information processing system claim 26 and are rejected for the same reasons.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 12,8-9,13-23,25,27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Horman [US. Pat. No. 6,785,706], in view of Dan et al. [US. Pat. No. 6,560,639].

As to claim 12, Horman discloses a method of synchronizing configuration parameters on a server with a database of stored configuration parameters (col. 6, lines 11-17) comprising automatically updating [*a server application which provides a high-level view of how an administered server synchronize (col. 8, line 60-col. 9, line 5)*] at least one application program configuration parameter in response to updating at least one corresponding stored

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application configuration parameter in said database, wherein each application program configuration parameter [embedded *parameters*] defines at least in part a set of resources on the server [col. 2, lines 50-61 & col. 3, lines 17-36].

Horman does not explicitly disclose the set of resources on the server available to a particular customer of the a web hosting provider.

Dan discloses a web management system including a database that includes a server side software package that allows users to manage web sites (col. 2, lines 18-24). An asset (resource) (col. 13, lines 42-47) is available to everyone on the user's web management team (particular user entity) (col. 14, lines 38-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Dan's teachings to modify the method of Horman by providing a set of resources on the server available to a particular customer of the web hosting provider in order to provide to enable users to interface with a web management server side application to eliminate the cost of shrink –wrapping and facilitate optional automatic online software upgrades.

As to claim 8, Dan further discloses comprising reversing a database update in the event of an indication of an error during the process of updating the server (col. 3, lines 3-6).

As to claim 9, refer to claim 8 rejection.

As to claims 13,15-17, Dan further discloses wherein the set of resources comprises disk space, memory space, communication bandwidth, processor capacity (Fig. 2, database 50, is a memory space that stored in the WebPages).

As to claim 14, Dan further discloses wherein the set of resources comprises a network address (Fig. 2, database 50, is a network resource available to user 10).

As to claim 18, refer to claim 12 rejection.

As to claims 19, 21-23 refer to claims 13, 15-17 rejection.

As to claim 20, refer to claim 14 rejection.

As to claim 25, Horman discloses wherein the server is operated by a web-hosting provider and each application program configuration program parameter defines at least in part a set of resources on the server (col. 5, lines 24-32).

Horman does not explicitly disclose the set of resources on the server available to a particular customer of the a web hosting provider.

Dan discloses a web management system including a database that includes a server side software package that allows users to manage web sites (col. 2, lines 18-24). An asset (resource) (col. 13, lines 42-47) is available to everyone on the user's web management team (particular user entity) (col. 14, lines 38-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Dan's teachings to modify the method of Horman by providing a set of resources on the server available to a particular customer of the web hosting provider in order to provide to enable users to interface with a web management server side application to eliminate the cost of shrink -wrapping and facilitate optional automatic online software upgrades.

As to claims 27, refer to claim 25 rejection.

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15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (571) 272-3897. The ex If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Caldwell Andrew, can be reached on (571) 272-3868. The fax phone number for this Group is (571)-273-3897.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) **273-8300**.

Hieu Le

A handwritten signature in black ink that reads "Andrew Caldwell". The signature is written in a cursive, flowing style.

**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**